

REMARKS

Claims 31-43 are pending. By this Amendment, no claims are cancelled, no claims are amended and no new claims are added.

35 U.S.C. § 112

The Office Action rejected claims 31 and 36 under 35 U.S.C. § 112 as failing to meet the enablement requirement. The Office Action indicates that in claim 31 the language “allowing selection of a region of the compressed medical image at the second location” is not enabled. The Office Action further indicates that in claim 36 the language “receiving said compressed medical image, a viewing part enabling said image to be viewed and enabling a region of said image to be selected” is not enabled. Applicant respectfully traverses the rejection.

With regard to this rejection, the Examiner has previously pointed to comments made in an Amendment filed January 3, 2007. With this amendment Applicant has filed a declaration by Dr. Rui-Tao Dong attesting that, based on his knowledge and experience in the field of machine vision, one of skill in the art would be enabled to make and use the invention by the disclosure of the Application as filed. Dr. Dong also attests that it is common term of art in this field to refer to an image that has undergone lossy image compression and then been uncompressed as a “compressed image.” An image that has undergone lossy compression and then been uncompressed may appear identical to the uncompressed original image to a human observer. However, the data loss that occurs in lossy compression and uncompression may create errors in a computerized image analysis performed by computer equipment. Thus, when

the claims refer to the “compressed image” this is the understanding that one of skill in the art would have.

The enablement requirement is defined in 35 U.S.C. § 112, which reads in-part: “The specification shall contain a written description of the invention and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains or with which it is most nearly connected to make and use the same.” Liebel-Flarsheim Co. and Mallinckrodt, Inc. v. Medrad, Inc., 481 F.3d 1371, 1377 (Fed. Cir. 2007). Generally, an invention is not enabled if one of ordinary skill in the art would be required to engage in undue experimentation in order to make and use the invention. *Id.* at 1378. Applicant respectfully takes the position that in view of the evidence submitted herewith that one of ordinary skill in the art would not be required to engage in undue experimentation to practice the invention as claimed.

With this amendment Applicant has a filed a declaration by Dr. Rui-Tao Dong attesting that, based on his knowledge and experience in the field of machine vision, one of skill in the art would be enabled to make and use the invention by the disclosure of the Application as filed.

As further evidence that one of ordinary skill in the art would have been enabled to make and use the invention by the specification at the time the specification was filed, Applicant respectfully submits the following additional items of evidence which were in existence prior to the filing of the present application.

A document dated November 5, 1995 found on the world wide web entitled "NCSA Image Map Tutorial." A copy of the reference is included for the Examiner's convenience. The reference indicates that image maps are predefined coordinate ranges that can then be selected to perform other tasks. This represents one example how one of ordinary skill in the art could allow selection of a region of the compressed medical image at the second location as recited in claim 31 and how one of ordinary skill in the art could make a "a network communicating part receiving [a] compressed medical image" and "a viewing part enabling said image to be viewed, and enabling a region of said image to be selected" as recited in claim 36.

Also presented as evidence are excerpts from a textbook entitled "JavaScript – The Definitive Guide" that was published in 1998. Applicant directs the Examiner attention to page 135 and the section entitled "Prototypes and Inheritance". Herein the author provides instructions how to define an image map of a circular object having a radius R drawn from a centerpoint and a rectangular coordinate location of the centerpoint from which the radius is drawn having a location of x and y. This provides another example as to how one of ordinary skill in the art would be able to allow selection of a region of the medical image at the second location and to make a "a network communicating part receiving [a] compressed medical image" and "a viewing part enabling said image to be viewed, and enabling a region of said image to be selected" as recited in claim 36.

Further evidence can be found in excerpts from a textbook entitled "Beginning Java 2" published March 2000. Applicant directs the Examiner's attention to a section entitled "Displaying the Image" in a chapter entitled "Images and Animation" from pages 875 to 879. In particular, the illustration on page 877, describes how Java 2 may be used to identify and scale a rectangular image based on user coordinates. This is a further example as to how one of ordinary skill in the art would be able to allow selection of a region of the medical image at the second location and to make a "a network communicating part receiving [a] compressed medical image" and "a viewing part enabling said image to be viewed, and enabling a region of said image to be selected" as recited in claim 36.

In view of the foregoing, the portion of claim 31 cited by the Examiner would be enabled by the present specification in light of the knowledge of one of ordinary skill in the art at the time the application was made. Applicant respectfully requests that the Examiner withdraw the rejection.

Claims 32-35 depend from claim 1 and are allowable for at least the same reasons as claim 31.

With regard to claim 36, the Examiner indicated that the language "receiving said compressed medical image, a viewing part enabling said image to be viewed and enabling a region of said image to be selected." Applicant assumes the Examiner's rejection relates to the portion of claim 36 reading, "a viewing part enabling said image to be viewed and enabling a region of said image to be selected." Referring to the evidence presented above, and the discussion above, Applicant respectfully submits that the above-identified evidence demonstrates the one of ordinary skill in the art would have been enabled to provide a viewing part enabling

said image to be viewed and enabling a region of said image to be selected. The references cited provide examples of ways in which one of ordinary skill in the art would be able to make and use the invention without undue experimentation, indeed with very little or no experimentation because of the examples provided herein. Applicant respectfully requests that the Examiner withdraw the rejection.

Claims 37-43 depend from claim 36 and are allowable for at least the same reasons.

Applicant respectfully request that the Examiner withdrawing the rejection.

In view of the foregoing, it is submitted that this application is in condition for allowance.

Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



Paul C. Onderick
Registration No. 45,354

Customer No. 24113
Patterson, Thuente, Skaar & Christensen, P.A.
4800 IDS Center
80 South 8th Street
Minneapolis, Minnesota 55402-2100
Telephone: (612) 349-5766